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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,537

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Karl-Heinrich Herber

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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

EXAMINER

THEODORE, MAGALI P

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,537	Applicant(s) HERBER, KARL-HEINRICH	
	Examiner Magali P. Théodore	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 4-15 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

1. Applicant's election with traverse of group I, claims 4-11, in the reply filed on June 23, 2008 is acknowledged.

The traversal is on the grounds that "the claims do share the *special technical feature*... where an edge of a shoe upper piece is disposed inside of an inner side of an inner sole." Whether or not a technical feature makes a "contribution" over the prior art and therefore constitutes a "special technical feature" is considered with respect to novelty and inventive step. (MPEP [R-6] 1850 II.) As evidenced by Liebscher et al. (US 4,003,145), discussed further on in this action, lacks novelty. Therefore, the technical feature indicated by Applicant is not a *special technical feature* and does not impart unity of invention to the claims.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 12-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 23, 2008.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 7, 10 and 11 are rejected under 35 U.S.C. 102(b) as being Liebscher et al. by (US 4,003,145), henceforth Liebscher.

Regarding claim 7, Liebscher discloses a method of making shoes by placing an edge of an inner sole on the edge of a casting mold, placing an edge of a shoe upper piece (fig 4 part 1) in the mold and inside the an inner side of the inner sole (fig 4 part 15), and pressing the two together (col 2 ln 15-21).

Regarding claim 10, Liebscher teaches aligning inner surfaces of the upper piece and inner sole (fig 4).

Regarding claim 11, Liebscher teaches sewing together the upper piece and inner sole (col 1 ln 39-40).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartneck (US 4,333,193) in view of Liebscher.

Regarding claim 4, Bartneck discloses a method making a shoe within a casting mold with an upper edge (fig 3 parts 30, 32), the shoe made of an upper piece (fig 3 part 2) which is formed of an upper and an inner sole (fig 3 part 14) fastened to it, the upper piece bonded to the sole in an assembled shoe, by inserting a fillet (fig 3 part 6) into the upper, filling the casting mold with a shoe base material (col 2 ln 31-32), placing the edge of the upper piece on the casting mold edge from above (col 2 ln 29-30, 33-35), placing a pressing frame (fig 3 part 24) on the upper piece edge and thus on the casting mold edge, wherein only the upper piece edge rests on the casting mold edge and wherein the upper is fixed internally to the inner sole such that the shoe base material presses the inner sole against an edge of the upper that is adjacent to the fillet (col 2 ln 36-38).

Bartneck does not teach placing an edge of the inner sole on the casting mold edge. Bartneck's method inverts the roles of the upper piece and the inner sole. However, whether to display the inner sole or the upper piece on the exterior of the finished shoe is a matter of design choice based on aesthetic preferences. Bartneck's treating the edge of the upper piece as decorative is evidence by his use of non-functional stitching (fig 2 part 8) along that edge in addition to the functional seam (fig 2

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part 4). Liebscher teaches having edge of an inner sole (fig 4 part 15) extend over the outer sole (fig 4 part 4) in order to visually aggrandize the sole for aesthetic reasons (col 1 ln 10-12). Therefore, it would have been obvious to one of ordinary skill in the art to use the exposed edge of inner sole as the “mold engaging lip” (col 3 ln 3) and place it on the casting mold edge taught by Bartneck because Liebscher teaches having an inner sole extend over the outer sole to the total sole look bigger.

Regarding claim 5, Bartneck teaches that upper piece and inner sole are connected by a seam (fig 2 part 4).

Claim 6 recites that the upper piece is the strap of a sandal. This limitation defines the type of *product* being made; it does not change or affect the steps that constitute the *method*. Therefore, this recitation does not impart patentable distinction to the method being claimed. In any case, it would have been obvious to one of ordinary skill in the art to replace the brogue upper piece (fig 1 part 2) with an upper corresponding to a sandal, an athletic shoe or a espadrille because there is a market for these and many other types of shoes.

Regarding claim 7, Bartneck discloses a method making a shoe by placing an edge of an upper piece (fig 3 part 10) on the edge (fig 3 parts 30, 32) of a casting mold, placing an edge of the shoe's inner sole (fig 3 part 14) in the mold and inside an inner edge of the upper piece, and pressing these two together (col 2 ln 33-36).

Bartneck does not teach placing an edge of the inner sole on the casting mold edge. Bartneck's method inverts the roles of the upper piece and the inner sole. However, whether to display the inner sole or the upper piece on the exterior of the

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finished shoe is a matter of design choice based on aesthetic preferences. Bartneck's treating the edge of the upper piece as decorative is evidence by his use of non-functional stitching (fig 2 part 8) along that edge in addition to the functional seam (fig 2 part 4). Liebscher teaches having edge of an inner sole (fig 4 part 15) extend over the outer sole (fig 4 part 4) in order to visually aggrandize the sole for aesthetic reasons (col 1 ln 10-12). Therefore, it would have been obvious to one of ordinary skill in the art to use the exposed edge of inner sole as the "mold engaging lip" (col 3 ln 3) and place it on the casting mold edge taught by Bartneck because Liebscher teaches having an inner sole extend over the outer sole to the total sole look bigger.

Regarding claim 8, Bartneck teaches that the pressing step includes expanding a shoe base material (col 2 ln 33-39).

Regarding claim 9, Bartneck teaches that the pressing step forms an indentation on the inner side of the inner sole (fig 3 part 14).

Regarding claim 10, Bartneck teaches aligning inner surfaces of the upper piece and inner sole (fig 3 parts 2, 14).

Regarding claim 11, Bartneck teaches sewing together the upper piece and inner sole (col 2 ln 22).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magali P. Théodore whose telephone number is (571) 270-3960. The examiner can normally be reached on Monday through Friday 9:00 a.m. to 5:30 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Magali P. Théodore/
Examiner, Art Unit 1791

/Christina Johnson/
Supervisory Patent Examiner, Art Unit 1791